III. Remarks

In view of the foregoing amendments and the following representations, reconsideration and allowance is respectfully requested.

Claims 13-22 and 24-28 are pending. In the Final Office Action, the Examiner withdrew Claims 26-28 from consideration pursuant to a species election. Claims 13-18, 21, 22, 24, and 25 were rejected under 35 U.S.C. § 103(a), as defining subject matter that is allegedly obvious over U.S. Patent No. 2,420,191 to Ransom (hereinafter "Ransom") in combination with U.S. Patent No. 4,256,603 to Ibsen, *et al.* (hereinafter "Ibsen"). Claims 13, 14, 19, 21 and 24 were rejected under 35 U.S.C § 103(a), as defining subject matter that is allegedly obvious over U.S. Patent No. 4,037,766 to Iacono (hereinafter "Iacono") in combination with Ibsen. Claim 20 was rejected under 35 U.S.C. § 103(a), as defining subject matter that is allegedly obvious over the combination of Ransom, Ibsen and U.S. Patent No. 4,022,363 to Eliassen (hereinafter "Eliassen"). Additionally, Claim 24 was objected to for improper format.

At the outset and before addressing the rejections raised in the Official Action, the Applicant has amended Claim 24, to independent form to more clearly recite the features therein. Support is found throughout the specification. No new matter is added via this amendment.

Applicant traverses the imposition of a species election requirement and withdrawal of Claims 26-28 from consideration. Moreover, Applicant reserves the right under 35 U.S.C. § 121 to file one or more divisional applications directed to the non-elected subject matter in this application.

Turning to the 35 U.S.C. § 103(a) rejections, Applicant respectfully traverses these rejections, and requests reconsideration.

The present invention is directed to a container arrangement which prevents the sequence from getting confused during removal of the containers. Therefore, for components for medical or dental treatment, the present invention aims at preventing medical errors, and resulting increased patient morbidity and mortality.

According to the Examiner, as set forth in the Final Office Action, Ransom teaches a retaining device with an accommodating opening for the containers and designed for removal of

the containers in a fixed sequence. The Examiner acknowledges that Ransom does not teach containers filled with material for dental restorative work and relies on Ibsen to teach same.

The Examiner further made the observation that Iacono teaches a retaining device with an accommodating opening designed for removal of the contents in a fixed sequence. The Examiner acknowledges that Iacono does not teach containers filled with material for dental restorative work and relies on Ibsen to teach same. For both rejections the Examiner states it would have been obvious to one of ordinary skill in the art at the time the invention was made to have incorporated the use of containers filled with material for dental restorative work as disclosed by Ibsen in the retaining device disclosed by Ransom or Iacono.

Applicant respectfully disagrees inasmuch as the prior art "could not" have been combined. The combination of the bottle holders of Ransom or Iacono with the small containers as shown in Fig 1 and 7 of Ibsen, renders the Ransom, Iacono, and Ibsen devices inoperable. The Federal Circuit has stated:

> "We have noted elsewhere, as a "useful general rule," that references that teach away cannot serve to create a prima facie case of obviousness...If references taken in combination would produce a "seemingly inoperative device," we have held that such references teach away from the combination and thus cannot serve as predicates for a *prima facie* case of obviousness." McGinley v. Franklin Sports Inc., 262 F. 3d 1339, 60 USPQ2d 1001, 1010 (Fed. Cir. 2001); In *re* Sponnoble, 405 F.2d 578, 587, 160 USPQ 237, 244 (C.C.P.A. 1969).

Furthermore, Applicant maintains disagreement with the Examiner's interpretation that the cited references are designed for removal of the contents in a fixed sequence. A sequence is an ordered arrangement of removal. There is no fixed sequence of removal in any of the four references cited. That is, there is no consistent rule that determines the next container in the sequence to be removed. In Ransom, as seen in Figure 3, and as described at column 2, line 29, there is a "plurality of notches". The bottles of the Random device may be removed in any of a number of sequences from each of the arms. Such removal is **not** fixed: 1) A and D, B and E,

and C and F; 2) A, B, C, D, E, F; 3) D, E, F, A, B, C; 4) D, E, A, F, B, C, and so on. From the multitude of slots removal of bottles can be from either slot at any time, so there is no predefined or fixed removal sequence. Similarly, for the Iacono reference, there are three lanes and the bottles may be removed in any of a number of sequences or permutations from each lane. Again, such removal is **not** fixed: 1) all three bottles could be removed from lane 1, then all three from lane 2, then all three from lane 3; 2) one bottle from each lane could be removed at a time; 3) two bottles from lane 1, two from lane 2, two from lane 3, followed by the final bottles from lane 2 and 3 simultaneously, followed by the final bottle from lane 1, and so on. Similarly, removal of the components from the Ibsen device involves no order whatsoever and is **not** fixed. That is, any component can be removed in any sequence so that if there are 10 components there are 10 factorial permutations or 3,628,800 variations for removal.

There are a number of other features of the present invention which are not suggested by either Ransom or Iacono. Unlike either Ransom or Iacono, the accommodating openings of the present invention can be widened elastically for removal of a container. Moreover, neither Ransom nor Iacono have two grip surfaces from the edges. Ransom has only one handle originating from the middle section and Iacono has only one handle as well.

Unlike the present invention which is a "U" shaped retaining device for containers and container arrangement, Ransom is a "W" shaped bottle holder, and Iacono has a multiple bottle carrier slots of the bottle-neck gripping type. Moreover, the Ransom and Iacono devices are inoperable for the containers of the present invention. Unlike the present invention where the containers do not come into contact with the underlying surface because of a standing surface (10), Ransom does not have a standing surface and the milk bottle type wide-bottom container bottoms remain upright. Conversely, the present invention containers, are narrow small-quantity containers which, when placed in the Iacono device will topple over. Moreover, the present invention has profiling for securing the tube-like containers of the present invention. Neither Ransom nor Iacono have profiling for securing the containers. Instead these devices are intended for bottles having a narrowing, i.e., a bottleneck. As such, neither Ransom nor Iacono are capable of use with the containers of the present invention and placing the containers of the present invention into the retaining devices of either Ransom and Iacono will cause the containers to fall out and break. Inasmuch as the combination renders the Ransom and Iacono

devices inoperable for their intended purpose, these references teach away teach away from the present invention.

With regard to Claim 20, the Examiner takes the position that Ransom and Ibsen disclose the invention except for the ability to prevent primary opening of the containers. That is, access to the contents of the containers of the present invention can only be obtained upon removal of the containers from the retaining device. Eliassen is relied upon for a retaining device with a shield over the top of the accommodating opening to protect the containers and prevent opening of the containers prior to removal from the retaining device. According to the Examiner, it would have been obvious to have incorporated the use of a shield over the top of the accommodating opening as disclosed by Eliassen in the retaining devices disclosed by Ransom and Ibsen to protect the containers and prevent opening of the containers prior to removal from the retaining device.

Inasmuch as Claim 20 is dependent upon claim 13, the present invention cannot be rendered obvious over the combination of Ransom, Ibsen and Eliassen for at least the reasons provided above. Further, .."it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior references, so that the claimed invention is rendered obvious." In *re* Feitch, 972 F.2d 1260, 23 U.S.P.Q. 2d 1780, (Fed. Cir. 1992).

All of the references cited are non-analogous. Ransom, Iacono and Eliassen are not in the field of the inventor's endeavor and Ibsen is not reasonably pertinent to the specific problem of the present invention. Ibsen is completely silent about any measure of defining a removal sequence. Both Ransom and Eliassen explicitly refer to multitudes of slots and neither reference addresses the problem underlying the present invention. There is no predefined removal sequence, nor would same be useful for these types of devices. These references refer to devices for transportation and/or storage of beverage bottles. Therefore, there is no incentive for a person skilled in the art to combine the teachings of Eliassen and Ransom, nor would such combination result in the present invention.

In fact, none of the references cited addresses the problem underlying the present invention. Ibsen is silent regarding a removal sequence. It is respectfully submitted that there is

no incentive for the person skilled in the art to combine the references to obtain the present invention. In contrast, the Examiner has applied impermissible hindsight. Moreover, inasmuch as none of the documents even address the problem of the present invention, there is no incentive to combine any of the references.

In consideration of the differences between the present invention and the Ransom, Ibsen, Iacono, and Eliassen references, as explained above, it is submitted that the claims define subject matter that is patentable over the prior art, and withdrawal of the rejection is in order and is respectfully requested.

The above amendment and remarks establish the patentable nature of all the claims examiner on the merits in the application. Notice of Allowance and passage to issue is therefore, respectfully solicited.

Any fee due with this paper may be charged to Deposit Account 50-1290.

Respectfully submitted,

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